

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Collings III, John Serial No. 09/858,403 Filed: 05/16/2001 For: “Event Notification System”	Group Art Unit: 2142 Examiner: Vu, Thong H. Customer Number: 25854
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REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
Mail Stop Amendment
P.O. Box 1450
Alexandria, VA 22313-1450

April 11, 2006

Sir,

In the above-styled matter, Applicant has filed a Notice of Appeal (PTO/SB/31) and a Request for Pre-Appeal Brief Review (PTO/SB/33). The reasons for filing the Request are set forth below.

BACKGROUND

A first Office Action was issued on September 2, 2004, in which the Examiner rejected all of the claims, but indicated that Claim 6 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. Applicant responded to this action by canceling Claims 1 and 26-65, amending Claim 6 to include the limitations of Claim 1 and amending all of the remaining claims to depend from amended Claim 6.

A second Office Action was issued on May 23, 2005. Rather than allowing the claims, all of the claims were rejected under 35 U.S.C. §§ 101, 112 and 103 (citing U.S. Patent Nos. 6,571,285 and 5,566,339). Applicant responded to the § 101 rejection by presenting arguments as to why the rejection was improper and responded to the § 112 rejection by amending the claims slightly and also presenting arguments as to why the rejection was improper. Applicant responded to the § 103 rejection by distinguishing the elements of the claims from the passages cited in the Action.

A third Office Action was issued October 3, 2005, in which all of Applicant's arguments presented in the Response to the second Office Action were asserted to be moot in view of new grounds for rejection. All of the claims were, once again, rejected. It appears as though the Examiner accepted all of Applicant's arguments regarding the §§ 101 and 112 rejections. This time, however, Claim 6 was rejected under 35 U.S.C. § 112 on the previously-unasserted grounds that it contained a negative limitation. All of the claims were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,647,432, in view of U.S. Patent No. 5,566,339. Applicant responded to the § 112 rejection by pointing out that Claim 6 did not include a negative limitation and, even if it did, that there is no prohibition on negative limitations. Applicant responded to § 103 rejection by pointing out that the cited references completely fail to show any of the limitations recited in the corresponding claims.

A fourth Office Action was issued on February 15, 2005, in which all of Applicant's arguments presented in the Response to the third Office Action were, once again, asserted to be moot in view of still new grounds for rejection. It appears as though the Examiner accepted Applicant's arguments regarding the new § 112 rejection. However, all of the claims were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,960,337 in view of U.S. Patent No. 5,504,476.

ARGUMENTS WITH RESPECT TO LATEST OFFICE ACTION

Applicant asserts two arguments as to why the Appeal should be granted: (1) the cited references do not disclose the recited elements of Claim 6; and (2) the citations in the Action are so imprecise that it is impossible to determine the grounds for the rejection.

For a few examples of how the cited references do not show the recited elements of Claim 6, the fourth Action states that the '337 patent discloses the limitation of "transmitting from a central computer at a central notification processing center to a first individual, via a not-automatically receipt confirmed transmission medium," stating that "an EAS operator transmits an emergency call to available EAS responder/technician," without citing any portion of the '337

patent in support thereof. Even if the the '337 patent showed what Action asserts, it still does not show the limitation of transmitting "via a not-automatically receipt confirmed transmission medium," as recited in Claim 6. Regarding the second element of Claim 6, the cited figures (Figs. 3A-D) simply do not show the recited limitation of "upon receiving, by the central computer, a response communication from the first individual, transmitting a request from the central computer to the first individual requesting that the first individual respond *with the first event codes*," but merely shows that different types of responders are required for different types of emergencies. Regarding the limitation of "if the first individual responds by transmitting the first event codes then identifying the event from the first event codes" the Examiner merely states that the '337 patent shows "the first EAS responder responds to the call" (again without citation to the '337 patent). Even if this assertion were to be correct, there still was no assertion that the '337 patent shows the limitation of "identifying the event from the first event codes," as recited in Claim 6 (and, the lack of such an assertion notwithstanding, the '337 patent does not show this element).

Similarly, with respect to most of the remaining elements of Claim 6, each of the asserted portions of the '337 patent simply do not relate to the corresponding recited element that the Action asserts as being disclosed, and they certainly do not teach or suggest the element.

Some of the rejections are so imprecise as to be impossible to evaluate. For example, regarding element (h.) the Examiner cites the Abstract and a passage beginning at column 5, line 50 and ending at column 13, line 251 (*sic*) – requiring the reader to filter through roughly eight columns of text in the '337 patent to find an alleged disclosure of the contested element! Even after reviewing the cited eight columns, Applicant is unable to find the contested element, or anything reasonably equivalent thereto.

Paragraph 4 of the Action states that the remaining claims (Claims 2-5 and 7-26) "contain the similar limitations set forth in claim 6. Therefore claims 2-5, 7-26 are rejected for the same rationale set forth in claim 6." Firstly, Applicant traverses the assertion that the limitations recited in Claims 2-5 and 7-26 are the same as set forth in Claim 6. If that were true, then the


proper assertion would be a Duplicate Claims objection pursuant to MPEP 706.03(k) – which was never asserted in any of the four Office Actions issued in this case. Secondly, a reading of these claims clearly shows that they all have limitations distinguishable from those of Claim 6. However, the Action failed to include any sort of comparison of the rejected claims to the cited references on an element-by-element basis. (In fact, it failed to provide any guidance as to the basis for the rejection at all!).

CONCLUSION

It is for these reasons that Applicant has filed the present Notice of Appeal. Furthermore, Applicant respectfully requests that all remaining claims be allowed and that a timely Notice of Allowance be issued.

No addition fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees that may be required, including any necessary extensions of time, which are hereby requested, to Deposit Account No. 503535.

04/11/2006
Date


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